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PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. §1.111

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users attaches to an associated one of said digital information blocks; and

each of the third users is presented with a link list ordered responsive the indicia associated with the links stored in the buffer memory.

### REMARKS

Claims 1-10, 29-32, 35, 39-98, and 103-113 are pending in the application. In the amendment, claims 11-28, 33-34, 36-38, 99-102, and 113-114 are cancelled without disclaimer of or prejudice to the subject thereof while claims 4, 35, 39, 48, 78, and 103 are amended, as discussed in greater detail below.

The specification is objected to under 35 U.S.C. §132. In particular, the Preliminary Amendment filed on December 11, 2000, which provided a substitute specification for entry allegedly contains new matter, i.e., "work product summary" (pages 3, 17, and 18) and "parsing of the work order packages into work order summaries and work orders (page 19). This objection to the substitute specification is respectfully traversed.

It is well settled that new matter is that which is not found in the Specification or drawings as first filed and which involves a departure from the original invention. In other words, new matter is material which is not explicitly, implicitly, inherently or intrinsically present in a patent application as of its effective filing date. See In re Oda, 170 U.S.P.Q. 268 (C.C.P.A. 1971). Amendments which describe the invention in much more detail and amendments which clarify and complete the original disclosure do not rise to the level of introducing new matter. See, for example, In re Heinle, 145 U.S.P.Q. 131 (C.C.P.A. 1965).

Moreover, it is respectfully submitted that the new matter objection is predicated on the fact that the specific terminology employed in application, i.e., both the specification and the claims, does not appear in the application as originally filed.

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However, it is well settled that the burden of showing that the claimed invention is not described in the application rests on the Patent and Trademark Office in the first instance, and it is up to the Patent and Trademark Office to give reasons why a description not *in ipsius verbis* is insufficient. See *In re Edwards et al.*, 196 U.S.P.Q. 465,9 (C.C.P.A. 1978). The Office Action merely identifies terminology that was not literally present in the application as filed; it prevents no cogent reasoning or rationale proving that the disclosure as originally filed did not explicitly, implicitly, inherently or intrinsically convey such concepts.

In the discussions regarding new matter with respect to both 35 U.S.C. §132, presented immediately below, and 35 U.S.C. §112, 1<sup>st</sup> paragraph, discussed in detail below, Applicant will identify support for the terms found on the December 11, 2000 amendment found in U.S. Patent No. 6,006,191, the parent to the instant application.

With respect to “work order summary, it will be noted that the term “work order” appears in the ‘191 patent in the paragraph bridging columns 29 and 30. The discussion is as follows:

“Another interesting alternative method for operating the RAMIX system according to the present invention is the so-called open market direct bid method of operation. In an exemplary case, the patient transmits his/her EMR to CHC 200 via comm channel 210 as a work order the patient would like to receive bids on. The diagnostic physicians currently experiencing downtime would then bid against one another for the privilege of performing the reading.”

It will be appreciated that the “work order” is equated with “EMR,” i.e., Electronic Medical Record. From the discuss found in the ‘191 patent from column 1, line 42, to column 2, line 3, it will also be appreciated that the EMR consists of two parts, an electronic medical form (EMF) and an electronic medical image (EMI). Thus, the EMR is a multi-part package, i.e., a work order package. Moreover, with respect to the “parsing” objection, discussed in detail immediately below, it is clear that Applicant

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is merely substituting the terms "work order summary" and "work order" for EMF and EMI. Clarifications in language such as this do not amount to the introduction of new matter into the application. It is respectfully submitted that re-labeling of terms cannot amount to the introduction of new matter.

With respect to the "parsing" objection, it is unclear whether the objection is made regarding the term "parsing," the terms "work order summary" and "work order," or the phrase collectively. In any event, it is respectfully submitted that the entire phrase and its component parts are not new matter with respect to the '191 patent.

More specifically, the term "parsing" parsing

parse v., parsed, parsing, parses.

v.tr.

1. To break (a sentence) down into its component parts of speech with an explanation of the form, function, and syntactical relationship of each part.
2. To describe (a word) by stating its part of speech, form, and syntactical relationships in a sentence.
  - a. To examine closely or subject to detailed analysis, especially by breaking up into components: "What are we missing by parsing the behavior of chimpanzees into the conventional categories recognized largely from our own behavior?" (Stephen Jay Gould).
  - b. To make sense of; comprehend: I simply couldn't parse what you just said.
3. Computer Science. To analyze or separate (input, for example) into more easily processed components.

See <http://www.atomica.com>

As discussed in the '191 patent at column 24, lines 44-64. In particular, the '191 patent clearly states that:

"With this information at their disposal, the patient/gatekeeper advantageously can select an appropriate one of the PBQs reflective of the patient's needs and resources. When the patient's EMR containing a PBQ designation is transmitted to CHC 200, the operating system

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software of the CHC 200 automatically reads the appropriate field and assigns the patient's EMR to an appropriate location in the selected PBQ."

Thus, the clearing house computer (CHC 200) explicitly performs a parsing function.

Moreover, as also discussed in the '191 patent, the various parts of the EMR are transmitted separately. For example, column 27, lines 7-30, clearly state that "the CHC 200 transmits the EMR including patient information from the EMF, which preferably is displayed in area 412 on the screen of computer 410, and a preview image corresponding to either the sole or first digitized diagnostic image in the patient's EMI."

As mentioned above, the EMR defined as having at least two parts, an EMF and an EMI. Thus, the CHC 200 parses the EMR (the work order package) into an EMF (a work order summary) and an EMI (a work order).

For all the reasons set forth above, it is respectfully submitted that the substitute specification does not contain prohibited new matter. Thus, the Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. §132 objection to the substitute specification.

The Office Action also rejects claims 35, 46, 48, 49, 50, 69, and 78 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 1-10, 29-32, 35, 39-98, and 103-113 have been carefully reviewed and claims 4, 35, 39, 48, 78, and 103 are amended for clarity. It is respectfully submitted that claims 1-10, 29-32, 35, 39-98, and 103-113, as amended, are both definite and entirely proper under 35 U.S.C. '112, since those of ordinary skill in the art can easily ascertain the metes and bounds of the present invention from the pending claims.

First, it is respectfully submitted that Claims 35, 48, and 78 are amended at the points indicated in the Office Action.

Second, with respect to claims 46, 49, 50, and 69, it is submitted that the rejection

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is no cogent on several levels, not the least of which being that the phases become nonsensical when the Examiner rigidly assumes that articles such as "the" are always employed in signally antecedent basis. Such is not the case here.

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The first sentence of the second paragraph of 35 U.S.C. §112 requires only that claims "set out and circumscribe a particular area with a reasonable degree of precision and particularity." In the absence of evidence to the contrary, what the claim defines is what the applicant regards as his invention. If those skilled in the art can tell whether any particular embodiment is within the scope of a claim, the claim fulfills its purpose as a definition. See In re Miller, 169 U.S.P.Q. 597 (CCPA 1971). It is respectfully submitted that those skilled in the art would have no trouble determining the metes and bounds of the invention from the pending claims.

The Office Action then rejects claims 29-32, 35, 45-47, 55, 60, 64-69, 77, 78, 85, 89, and 93-98 under 35 U.S.C. §112, 1<sup>st</sup> paragraph, as containing subject matter which was not described in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time that the invention was made, had possession of the claimed invention, i.e., the claims fail as to written description. This rejection is respectfully traversed.

Due to the number of repetitive rejections, Applicant will address these rejections in tabular form.

| Term               | Rejected Claims | Support in U.S. Patent No. 6,006,191                      |
|--------------------|-----------------|---|
| time derivative    | 46, 69          | Claim 20, velocity, i.e., the time derivative of position |
| work order summary | 29, 35          | Addressed above   |

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| Parsing   | 29                        | Addressed above   |
| bar graph   | 45, 65, 66,<br>68, 94, 95 | Tables 1 and 2  |
| Arithmetic Calculations,<br>mean of the bar graph, time<br>derivative of the mean | 77, 78, 97,<br>98         | Column 24, lines 44-64. For<br>example, summing the number of<br>patients bidding \$100 for a reading is<br>an arithmetic calculation.                                      |
| <i>OK</i><br><del>Active</del> link   | 55, 60, 85,<br>89         | Column 24, lines 30-44. i.e., "the<br>contents of the PBQs and PMBs can<br>be <i>pointers, links or shortcuts</i> to the<br>actual EMRs containing the EMIs to<br>be read." |
| <del>Direct</del> computer link   | 64, 93                    | Column 24, lines 30-44. i.e., "the<br>contents of the PBQs and PMBs can<br>be <i>pointers, links or shortcuts</i> to the<br>actual EMRs containing the EMIs to<br>be read." |

Since the '191 patent clearly provides adequate support for allowing one of ordinary skill in the art to reasonably conclude that the Application had possession of the invention as presently claimed at least as early as May 12, 1997, the filing date of the '191 patent, the Examiner is respectfully submitted to reconsider and withdraw the 35 U.S.C. §112, 1<sup>st</sup> paragraph rejection of claims 29-32, 35, 45-47, 55, 60, 64-69, 77, 78, 85, 89, and 93-98.

The Office Action also rejects claims 4-8 under 35 U.S.C. §102(b) as being anticipated by Inga et al. (U.S. Patent No. 5,321,520). The '520 patent discloses a medical record storage system employed in, for example. This rejection is respectfully traversed.

In the Amendment, claim 4 was amended to recite features of the invention previously disclosed but unclaimed. In particular, claim 4 now recites "a second facility remote from the first facility, but in electronic communication therewith, for providing

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a diagnostic service provider having access to the electronic digital medical image database with a listing of the stored digital medical images negotiated by all of the N patients.” a feature of the invention neither disclosed nor suggested by the ‘520 patent. Thus, since the ‘520 patent does not disclose each and every feature of the claim arranged as in the claim, the ‘520 patent cannot anticipate amended claim 4. Claims 5-8, depending from claim 4, distinguish even further over the ‘520 patent and, thus, are allowable over this reference.

The Office Action also rejects claims 1, 3, 9, 10, 39-44, 48-54, 56-58, 61-63, 70-76, 79-84, 86-87, 90-92, 103-104, 106-111 and 113 under 35 U.S.C. §102(e) as being anticipated by Silverman et al. (U.S. Patent No. 5,135,501). This rejection is respectfully traversed.

The ‘501 patent teaches a system in which a computer matches buy and sell orders for currency based on messages generated by terminals attached to the system. In other words, the system in the ‘501 patent determines which trades will be executed based on both price and the system’s own criteria. The system also selectively displays information as determined by the system operator.

It is respectfully submitted that the ‘501 patent does not disclose or even suggest a graphic user interface (GUI), as commonly recited in many of the independent claims, e.g., claims 39 and 70. A GUI denotes an interface for issuing commands to a computer utilizing a pointing device, such as a mouse, that manipulates and activates graphical images on a monitor. The ‘501 patent does not disclose such an interface. Moreover, the ‘501 patent does not disclose or even suggest that:

1. “one of said second users elects to receive one of said digital information blocks responsive to said indicia of a respective digital information block,” as recited in claim 1;
2. The “self-organizing marketplace” and “all of the digital information blocks are freely selectable by at least one of the respective users,” as

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recited in claim 39.

3. The “self-organizing marketplace” and “whereby the GUI displays the graphic indicators for all offers to buy and sell to thereby permit all of the users to visualize the marketplace,” as recited in claim 70.
4. The “each of said digital information blocks is receivable by at least one of a plurality of third users,” as recited in claim 103.

For all of the reasons set forth above, the Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. §102(e) rejection of claims 1, 39, 70 and 103. The claims depending respectively from claims 1, 39, 70, and 103 are allowable over the ‘501 patent on identical reasoning.

It is respectfully submitted that the application is in condition for allowance, and such action is hereby solicited. However, if it is deemed that there still remain additional issues to be resolved, the Examiner is encouraged to call the Applicant’s undersigned representative prior to taking any further formal action in this case.

Respectfully submitted,

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